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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,174	11/30/2000	Michael A. Montgomery	40.0023 C1	5606

26751 7590 10/29/2003

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AUSTIN, TX 78726

EXAMINER

PATEL, NIKETA I

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 10/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

7

Office Action Summary

Application No.

09/727,174

Applicant(s)

MONTGOMERY ET AL.

Examiner

Niketa I. Patel

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 32-36 is/are allowed.
- 6) ☒ Claim(s) 37,42,46-53 is/are rejected.
- 7) ☒ Claim(s) 41 and 43-45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 42 is rejected under 35 U.S.C. 102(b) as being anticipated by Shinagawa et al.
Japanese Patent Number: JP401280889A (hereinafter referred to as “*Shinagawa*”).
3. **Referring to claim 42**, a computer system comprising: a terminal for communicating with smart cards [see figure 3 – elements 1, 2, 8]; the terminal having a means for simulating asynchronous communication with the smart card [see page 3 – lines 23-32.]

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

Art Unit: 2182

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 37, 46-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinagawa et al. Japanese Patent Number: JP401280889A (hereinafter referred to as “*Shinagawa*”) and further in view of Kawan U.S. Patent Number: 5,796,832 (hereinafter referred to as “*Kawan*”).)

7. **Referring to claim 37**, *Shinagawa* teaches a smart card comprising: means configured to communicate in an asynchronous manner to a smart card terminal [see page 6 – lines 22-27]; and means operable to use the means configured to communicate in an asynchronous manner to request resources selected from the set including terminal resources, host resources, and network resources [see page 7 – lines 3-13; page 8 – lines 11-16.] *Shinagawa* fails to explicitly set forth the limitation of network resources however, *Kawan* teaches a use of a smart card to access network resources [see *Kawan* column 4 – lines 43-56; column 6 – lines 13-35.]

One of ordinary skill in the art at the time of applicant’s invention would have clearly recognized that it is quite advantageous for the smart card of *Shinagawa* to be able to access network resources to allow a smart card user to access various peripherals connected to a host system. It is for this reason that one of ordinary skill in the art would have been motivated to implement *Shinagawa*’s smart card to allow a user to access various peripherals connected to a host system and to improve system flexibility.

8. **Referring to claim 46**, teachings of *Shinagawa* as modified by the teachings of *Kawan* as applied to claim 37 above teaches that the means configured to communicate in an

asynchronous manner [see *Shinagawa* page 6 – lines 22-27], however *Shinagawa* fails to explicitly set forth the limitation of a full duplex.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention that a full duplex was a well known type of a transmission mode in the computer art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement *Shinagawa's* invention with a full duplex transmission mode to allow for a bi-directional, simultaneous two-way communications.

9. **Referring to claims 47 and 48**, teachings of *Shinagawa* as modified by the teachings of *Kawan* as applied to claim 37 above that the means configured to communicate in an asynchronous manner [see *Shinagawa* page 6 – lines 22-27], however *Shinagawa* fails to explicitly set forth the limitation of a standard packet protocol and a network packet protocol.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention that a standard packet protocol and a network packet protocol were well known type of communication protocols in the computer art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement *Shinagawa's* invention with a standard and a network protocol to enable IC card to communicate with the resources to exchange information with as little error as possible.

10. **Referring to claim 49**, teachings of *Shinagawa* as modified by the teachings of *Kawan* as applied to claim 37 above *Shinagawa* fails to explicitly set forth the limitation of the network resources being identified using domain name services, however *Kawan* teaches use of an Internet to access network resources [see *Kawan* column 3 – lines 27-35, 43-56.]

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention that it was old and well known in the computer art to use a domain name services to access domain address. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include domain name services to access domain address of a desired domain.

11. **Referring to claims 50 and 51**, teachings of *Shinagawa* as modified by the teachings of *Kawan* as applied to claim 37 above *Shinagawa* teaches the network resources are accessed by remote message invocation and remote procedure call [see *Kawan* column 3 – lines 27-35, 43-56.]

12. **Referring to claims 52 and 53**, teachings of *Shinagawa* as modified by the teachings of *Kawan* as applied to claim 37 above *Shinagawa* teaches that the network resources enable various network devices [see *Kawan* column 4 – lines 43-56; column 6 – lines 13-35.] *Shinagawa* fails to explicitly set forth the limitation of the network resources enable network games and remote diagnostics.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention that it was old and well known in the computer art to use game and remote diagnostics devices as a network device to increase flexibility of the network and to perform various types of user tasks. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include games and remote diagnostics devices as part of the network resources to increase flexibility of the network and to perform variety of user tasks.

Response to Arguments

13. Applicant's arguments with respect to claims 32-45 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

14. Claims 32-36 are allowed.

15. Claims 41 and 43-45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niketa I. Patel whose telephone number is (703) 305 4893. The examiner can normally be reached on M-F 8:00 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on (703) 308 3301. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305 3900.

NP
October 23, 2003



Rehana Perræn
Art Unit 2182